

Remarks

Claims 1, 2, 4, 7 to 14, and 17 were rejected under 35 U.S.C. 103(a) as unpatentable over Lee in view of Pacheco. It is the Examiner's position that it would be obvious "to incorporate the teachings of Pacheco into the disclosed invention of Lee." Applicant does not agree. It is an object of Lee's invention "to provide a golf putting practice guiding device which is simple in structure, inexpensive to manufacture, ..." (column 1, lines 39 to 41). These objects cannot be achieved if the electronics of Pacheco are incorporated into Lee's device because the device would no longer be "simple in structure" and "inexpensive to manufacture." It is not obvious to incorporate Pacheco's teachings into Lee's device when doing so would destroy the objects of Lee's invention by making Lee's invention both more complex and more expensive to manufacture.

Further, in column 3, lines 11 to 14, Lee states, "In addition, it is easy for the practicing golfer to putt the golf ball 109 into the real hole in the golf green since the practicing golfer practices with a target having a smaller size than that of the real hole." That sentence indicates a further object of Lee's invention: to have a small target. While Pacheco indicates that his device is "smaller than a regulation-sized golf hole" (column 2, lines 66 and 67), the incorporation of Pacheco's electronics into Lee's device would still significantly enlarge Lee's device and work against his object of having a small target. For that reason also, it is not obvious to incorporate Pacheco's teachings into Lee's device.

It would further not be obvious to incorporate Pacherco's teachings into Lee's device unless it in some way improved Lee's device. Applicant sees no improvement to Lee's device that would result from such incorporation and, as explained in the previous paragraph, such incorporation would, in Lee's view, make his device less desirable. Applicant further notes, for example, that in Lee's device the bell will sound upon even slight contact with the ball. However, in Pacherco's device there will be no sound unless the ball has enough energy to roll up the base a distance sufficient to depress a pressure bar. For that reason, Lee's device is more sensitive than Pacherco's device and if Pacherco's teachings of using sloped pressure bars is incorporated into Lee the Lee device will be made less sensitive, which is not an improvement.

Applicant notes that Lee's bell will ring when a golf ball strikes his device coming from any direction. That is not true of Pacheco. Pacherco has four pressure bars 3 (see Figure 2). Each pressure bar 3 detects a golf ball coming from one of four directions. Referring to Figure 1 of Pacherco, if a golf ball rolls up base 2 in between two pressure bars 3, a pressure bar will not be depressed and there will be no audible sound. Referring to Figure 5 of Pacherco, there are four switches 6, one for each pressure bar 3. Thus, if the electronics of Pacherco is incorporated into Lee's device, Lee's device would have four pressure bars, each with its own switch, and could detect a golf bar coming from only one of those four directions. That would reduce the usefulness of Lee's device, not enhance it. It is for that reason also that it is not obvious to incorporate the electronics of Pacherco into the Lee device.

All of Applicant's claims now require that the sensor switch must close the electrical circuit when the golf practice device is struck by a golf ball coming from any direction (see original Claim 8 for support). Even if Pacheco's electronics were incorporated into Lee's device, the resulting device would still not fall within the scope of Applicant's claims.

All of Applicant's claims now also require an on-off switch to prevent the device from making sounds when it is not being used. Figure 5 shows the electrical circuit for Pacheco. There are 4 switches 6 that are closed by the pressure bars, but there is no on-off switch. That means that if you carry the Pacheco device around in your pocket, it will constantly be going off every time a pressure bar is bumped. Even if Pacheco's electronics is incorporated into Lee's device, the result will not fall within the scope of Applicant's claims because it will have no on-off switch. As Applicant pointed out in his previous amendment, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

Applicant's Claims 5, 15, and 20 require that the sound is that of a ball falling into a cup. If Pacheco's electronics were incorporated into Lee, the electronically-generated sound would be that of a bell, just as in Lee. There is no suggestion in any of the cited references to make the sound that of a ball falling into a cup, and it would therefore not be obvious to do this.

Applicant's Claims 6, 16, and 21 require that the sound is that of a human voice. If Pacheco's electronics were incorporated into Lee, the electronically-generated sound

would be that of a bell, just as in Lee. There is no suggestion in any of these references to make the sound of a human voice, and again, it would therefore not be obvious to do this.

Applicant's Claims 9, 14, and 19 require that the sensor switch is a metal spring mounted inside a metal ferrule, so that the metal spring contacts the metal ferrule when the golf practice device is struck by a golf ball. The cited references do not show this type of sensor switch and it would therefore not be obvious to use it.

Claims 5, 6, 15, and 16 were rejected under 35 U.S.C. 103(a) as unpatentable over Lee in view of Pacheco. The Examiner argues that it would have been obvious "to incorporate the sound of a ball falling into a cup or a human voice." Applicant does not agree. No references cited that use those sounds and there is no support for the Examiner's assertion that using such sounds would be obvious.

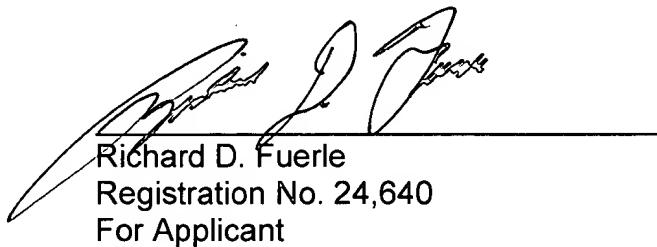
Claims 3, 18, 19, and 22 were rejected under 35 U.S.C. 103(a) as unpatentable over Lee in view of Pacheco further in view of Irving. Lee and Pacheco have been discussed. Irving was cited to show a base of material made of small hooks that can be releasably attached to a fabric. the Examiner seems to be suggesting that it would be obvious to take the "Velcro" off the bottom of Irving's tee and stick it on to the bottom of Pacheco's device in order to attach Pacheco's device to a carpet. However, Pacheco expressly states (column 2, lines 38 to 40) that one of the objects of his invention is "to allow golfer to move target away from previously putted balls by simply sliding the target to a new location with his putter." The "Velcro" would hold Pacheco's device to the

carpet, preventing Pacheco from achieving this object of his invention. Therefore, it is not obvious to combine Irving with Pacheco. An object of Lee's invention is to provide a putting aid that has "a supporting pin for securing the device into the ground such as a golf green" (column 1, lines 30 to 33). That object of Lee's invention would be defeated by combining Irving with Lee and it is therefore not obvious to do so.

Claims 20 and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Pacheco further in view of Irving. Lee, Pacheco, and Irving have already been discussed. Claims 20 and 21 depend from Claim 18, which is believed to be more than adequate to distinguish over these references.

All of the claims are now believed to be allowable over the references cited and reconsideration and allowance of all of the claims are therefore requested. Should the Examiner discuss the application he is invited to call Applicant's attorney at (716) 774-0091 to resolve any remaining problems.

Respectfully,



Richard D. Fuerle
Registration No. 24,640
For Applicant

Richard D. Fuerle
1711 West River Road
Grand Island, NY 14072
(716)-774-0091
September 4, 2003
CASE DL01